

Application Serial No: 10/768,940
Attorney Docket No.: 51890

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject matter identified in caption, as amended, and in light of the remarks which follow are respectfully requested.

Upon entry of the foregoing amendments, claims 1 and 3-11 will be pending in the application. By the amendments, the "photo-acid-generating component" has been deleted from claim 1 and added as new dependent claim 11. Entry of the amendments is proper at least because the application was prematurely placed under final rejection for the reasons presented below. Accordingly, entry of the amendments is respectfully requested.

Request to Withdraw Finality

Applicants respectfully request that the "final" status of the outstanding Official Action be withdrawn, as being premature. In this regard, MPEP 706.07(a) states that:

[S]econd or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement

Two new grounds of rejection were presented in the final Official Action which were not necessitated by applicants' previous claim amendments. More specifically, the final Official Action rejects claims 1 and 3-10 under 35 U.S.C. §103(a) over EP '923 (EP 1142923) in view of Smith et al (U.S. Patent No. 4,231,951) or Knudsen et al (U.S. Patent No. 5,262,280). Claims 1 and 3-10 were also rejected under §103(a) over Kiuchi et al '402 (U.S. Patent No. 6,730,402) or Kiuchi et al '776 (U.S. Publication No. 2003/0152776) in view of Smith et al or Knudsen et al. The previous Official Action issued July 6, 2005 included rejections of claims 1 and 3-7 under §102(b) over EP '923 and under §102(e) over Kiuchi et al '402 or Kiuchi et al '776. The "final" status is improper at least because the previous amendment to claim 4 involved only rewriting that claim in independent form – there was no substantive revision made to that claim. Such amendment could not therefore have necessitated the Office's new grounds of rejection.

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Accordingly, withdrawal of the "final" status of the outstanding Official Action is respectfully requested.

The Rejections

Turning now to the final Official Action, claims 1 and 3-10 stand rejected under 35 U.S.C. §103(a) over EP '923 in view of Smith et al or Knudsen et al. This rejection is respectfully traversed for the following reasons.

The present invention relates generally to the field of negative-type photosensitive resin compositions. Claim 1, as amended above, sets forth a negative-type photosensitive resin composition. The composition comprises an epoxy compound, poly(*p*-vinylphenol), and a phenol-biphenylene resin. Claim 4 sets forth a method for the formation of a resist pattern. The method comprises the steps of coating a negative-type photosensitive resin composition on a substrate, wherein the composition comprises an epoxy compound, poly(*p*-vinylphenol) and a phenol-biphenylene resin; exposing the resin composition; and developing of the exposed composition to form the resist pattern.

Kiuchi et al relates to an epoxy resin composition which can be used as a semiconductor encapsulating resin, and more specifically, to a flame retardant epoxy resin composition (page 2, lines 5-6). The epoxy resin composition comprises an epoxy resin (A), a phenolic resin (B), an inorganic filler (C) and a curing accelerator (D). (Abstract).

EP '923 does not disclose or suggest each feature of the presently claimed invention. For example, EP '923 does not disclose or fairly suggest a negative-type photosensitive resin composition that includes poly(*p*-vinylphenol), as recited in claim 1, or a method of using such a composition as set forth in claim 4. In setting forth the rejection, the Office relies on Comparative Example 10 of EP '923 (see final Official Action at page 2), stating that:

Kiuchi et al disclose a flame-retardant epoxy resin composition . . . The composition is prepared from an epoxy resin and 2 phenolic resins are demonstrated in Comp. Ex. 10 (page 23). Phenolic resin 2 employed in that composition is a: phenol-biphenylaralkyl. (Final Official Action at page 2).

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The Office relies on Smith et al and Knudsen et al for their alleged disclosures of photoinitiators with epoxy resins (Id.), concluding that:

It would have been obvious to . . . prepare the material of Kiuchi et al choosing to employ a photoinitiator to aid in the polymerization and curing of the resin layer as taught . . . by either Smith et al or Knudsen et al in the place of the curing agent. (Id.).

The Office has not addressed the presently claimed poly(*p*-vinylphenol) feature in the rejection. Upon review of EP '923, it should be clear that poly(*p*-vinylphenol) is not a component of the disclosed composition of Comparative Example 10. Thus, even if EP '923 would have been combined in the manner suggested in the final Official Action, the present invention would not have resulted. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1 and 3-10 stand rejected under 35 U.S.C. §103(a) over Kiuchi et al '402 or Kiuchi et al '776 in view of Smith et al or Knudsen et al. This rejection is respectfully traversed for the following reasons.

Kiuchi et al '776 and Kiuchi et al '402 are, respectively, the U.S. application publication and granted patent corresponding to Application No. 10/070,827. Kiuchi et al '402 and Kiuchi et al '776 relate to a flame-retardant epoxy resin composition, as well as to a varnish solution, a prepreg and a laminate all made with the composition. The flame-retardant composition includes an epoxy resin, a curing agent, and a metal hydroxide. The curing agent is a phenolic resin containing, in the molecular chain, structural units derived from a phenol and structural units derived from an aromatic compound other than the phenol, or the epoxy resin is a novolac epoxy resin obtained by subjecting the phenolic hydroxyl groups of the phenolic resin to etherification with glycidyl. (Abstract).

Kiuchi et al '776 and Kiuchi et al '402 do not disclose or suggest each feature of the presently claimed invention. For example, like EP '923, Kiuchi et al '776 and Kiuchi et al '402 do not disclose or fairly suggest a negative-type photosensitive resin composition that includes poly(*p*-vinylphenol) as recited in claim 1, or a method of using such a composition as set forth in claim 4. As with the rejection based on EP '923, the Office has not addressed the poly(*p*-vinylphenol) feature in the rejection. Thus, even

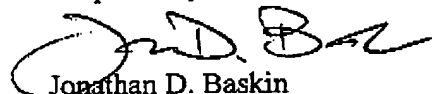
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Kiuchi et al '776 and Kiuchi et al '402 would have been combined with Smith et al and Knudsen et al in the manner suggested in the Official Action, the present invention would not have resulted. Simply put, the Office has not established a *prima facie* case of obviousness. Accordingly, withdrawal of this rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at her earliest convenience.

Respectfully submitted,



Jonathan D. Baskin

Attorney for Applicant
Registration No. 39,499
Telephone No.: (508) 787-4766
Facsimile No.: (508) 787-4730

c/o EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, Massachusetts 02205
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